



AF/3728

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Jimmy Tsen et al.
Serial No. : 09/994,439
Filed : November 26, 2001
Title : SHOE

Art Unit : 3728
Examiner : Marie D. Patterson

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
MAY 26 2004
TECHNOLOGY CENTER R3700

REPLY BRIEF

Pursuant to 37 CFR 1.193(b)(1), Applicants respond to the new points raised in the Examiner's Answer as follows.

In response to Applicants' statement that there is no suggestion to combine the references, the Examiner asserts the following:

Giese clearly and explicitly teaches and provides the motivation to combine the disclosed shoe soles with any other shoe construction. Giese clearly states that the sole construction comprising an outsole and a contoured midsole "creates a combined flexibility of the shoe bottom" and "a shoe is formed providing cushioning where needed and stability where needed." (see column 2 lines 14-22) This clearly provides motivation to use the disclosed composite outsole/midsole when cushioning, flexibility, and stability are desired. The fact that Giese shows numerous embodiments, merely suggests that it would have been obvious to use any of the disclosed sole structures including the one shown in figures 78-82. One of ordinary skill desiring to increase cushioning, flexibility and stability in a shoe (such as Taber) would clearly look to references such as Giese which clearly teach structures which provide such benefits. (See, Examiner's Answer, p. 6, second full paragraph. Emphasis added.)

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

May 19, 2004

Date of Deposit

Linda M. White

Signature

Linda M. White

Typed or Printed Name of Person Signing Certificate

Applicants disagree with the Examiner's characterization of Giese. Giese does not disclose that flexibility, stability and cushioning are provided by disposing a contoured midsole within an outsole as recited in Applicants' claims. Instead, Giese clearly states that these advantages result from providing a composite of a firm, wear-resistant layer and a softer second layer that have varying relative thicknesses. (*See* Giese, col. 2, lines 15-22.) Moreover, nowhere does Giese suggest that a shoe construction having a molded midsole disposed within an outsole would provide these advantages as suggested by the Examiner.

The Examiner further asserts, "the fact that Giese shows numerous embodiments, merely suggests that it would have been obvious to use any of the disclosed sole structures including the one shown in figures 78-82." Applicants disagree. There is simply nothing in the art of record that would lead the artisan to select the embodiment disclosed in Figures 78-81 and combine it with the shoe construction of Figure 7 in Taber. A determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. (*See, ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998). Because Applicants' claims are instead directed to a specific sole structure that includes a molded midsole disposed within an outsole, the Examiner must provide evidence that the references suggest the specific sole structure as recited in the claims, not any sole structure as suggested by the Examiner. Without such evidence, a *prima facie* case of obviousness cannot be maintained.

Moreover, in the instance where Giese does disclose his composite shoe bottom disposed within an outsole (*See*, Giese Figs. 78-81), he does not teach or suggest the use of a foxing to attach the upper as recited in Applicants' claims. Instead, Giese discloses "(t)he upper may be captured by the shoe bottom during the molding process to attach it to the shoe bottom." (*See*, Giese Col. 10, lines 46-48.) Thus, one of skill in the art reading Giese would not be motivated to attach the upper to the shoe using foxing as recited in Applicants' claims, but instead would be motivated to use the method actually suggested by Giese, that of attaching the upper during the molding process.

In view of the foregoing, Applicants assert that one skilled in the art reading Giese would not be motivated to combine the references as suggested by the Examiner. Instead, Applicants

Applicant : Jimmy Tsen et al.
Serial No. : 09/994,439
Filed : November 26, 2001
Page : 3

Attorney's Docket No. 06128-266001

assert that the Examiner is improperly relying on hindsight reconstruction of the references to pick and choose between isolated disclosures in the prior art to deprecate the invention. (*See, e.g., In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988)).

For these reasons, and the reasons stated in the Appeal Brief, Applicants submit that the final rejection should be reversed.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: May 19, 2004

Catherine M. McCarty Reg. No. 54,301
Catherine M. McCarty
Reg. No. 54,301

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906